

**Application No. 10/768,727****Amdt. in Response to Office Action of Jan. 7, 2005****UTILITY PATENT****B&D No. TN1697A****REMARKS**

Applicants have canceled Claims 1-7 and amended Claim 8. No other claims have been added or amended. Currently in the above-identified application therefore Claims 8-9.

The Examiner rejected Claims 1-9 under the doctrine of obviousness-type double patenting as being unpatentable over Claims 1-7 of US Patent No. 6,705,501. In response, Applicants will file a terminal disclaimer pursuant to MPEP § 804.02 upon allowance of Claims 8-9.

The Examiner rejected Claims 1-9 under 35 USC § 103(a) as being unpatentable over US Patent No. 5,219,110 ("Mukoyama") in view of US Patent No. 6,209,770 ("Perra").

Reconsideration and withdrawal of these rejections is respectfully requested.

Claim 8, as amended, calls for a fastening tool comprising a housing, a magazine connected to the housing for storing a fastener, a driving mechanism disposed within the housing for driving the fastener into a workpiece, a trigger assembly pivotally attached to the housing for activating the driving mechanism, the trigger assembly comprising a main trigger pivotally attached to the housing, and a supplemental trigger pivotally attached to the main trigger, a contact trip assembly comprising an upper contact trip contacting the supplemental trigger, and a lower contact trip connected to the upper contact trip, said contact trip assembly moving along a first direction substantially vertically to move at least one of the main trigger and the supplemental trigger, an adjuster supported by one of the upper contact trip and the lower contact trip, the adjuster having teeth that can mesh with teeth disposed on the other of the upper contact trip and the lower contact

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trip, the adjuster being movable between a first position where the teeth of the adjuster and the other of the upper contact trip and the lower contact trip mesh, and a second position where the teeth of the adjuster and the other of the upper contact trip and the lower contact trip do not mesh, wherein the adjuster moves between the first and second positions along a second direction substantially perpendicular to the first direction, a knob rotatably attached to the housing, and a link connected to the adjuster at one end and to the knob at the other end for moving the adjuster between the first and second positions upon rotation of the knob.

Admittedly, Mukoyama discloses the housing, magazine, driving mechanism, trigger assembly, and contact trip assembly. However, Mukoyama's adjuster does not move between a first position where the teeth of the adjuster meshes with opposing teeth on the contact trip, and a second position where the teeth of the adjuster and the contact trip do not mesh, in a direction substantially perpendicular to the contact trip's direction of movement. Instead, Mukoyama's adjuster moves vertically, i.e., parallel to the contact trip's direction of movement, between the first and second position.

By contradistinction, Claim 8 requires that "the adjuster move[] between the first and second positions along a second direction substantially perpendicular to the first direction," i.e., the contact trip's direction of movement, which is substantially vertical.

Because of this, the Examiner has relied on Perra which discloses an adjuster with meshing teeth. However, even if Mukoyama were to be combined with Perra, the resulting device would still not have a rotatable knob and a link for moving the adjuster to the second position. This is

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because the knob identified by the Examiner in Mukoyama (14b) is not rotated to move the adjuster to an unmeshed position. Instead, the knob 14b is pushed downwardly. Mukoyama, col. 4, lns. 22-33. Accordingly, if Mukoyama and Perra were combined, the Mukoyama knob would be used to push the Perra adjuster towards the second position, without any rotational action on the knob.

By contradistinction, Claim 8 requires a knob and link connected to the adjuster "for moving the adjuster between the first and second positions upon rotation of the knob." Since the Mukoyama/Perra device does not include such element, the Mukoyama/Perra combination cannot render Claims 8-9 unpatentable.

The Examiner attempts to use the present Specification to invalidate Claim 8. In particular, the Examiner quoted the Specification's statements that "persons skilled in the art shall recognize" that button 103, i.e., a knob, may be disposed in any place...so long as it can move the adjuster," in order to support his obviousness rejection. Such rationale is legally improper as the Examiner cannot rely on knowledge "gleaned only from applicant's disclosure" when making a any judgment on obviousness. See MPEP § 2145(X)(A), at 2100-161 (8<sup>th</sup> ed., Rev. 2, May 2004) (*quoting In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)). Accordingly, Applicants request that the Examiner refrain from relying on such improper rationale in the future examination of the present application.

No fee is believed due. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

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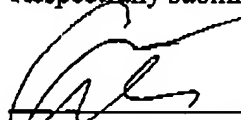
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In view of the foregoing, Claims 8-9 are patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



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